

## **REMARKS**

### **I. Status of the Claims**

Claims 2-9, 11-15 and 18-33 are pending in this Application. Claims 2-9, 11-15 and 19 have been amended to depend on claim 20 instead of claim 1. Claim 1 has been canceled without prejudice or disclaimer for filing in a continuing application. Applicants have amended claims 20 to recite that the benefit agent is an anti-acne agent. New claims 21-33 have been added. Support can be found in original claims 2-9, 11-15, and 19. Accordingly, no new matter has been introduced by this Amendment.

### **II. Claim Rejections Under 35 U.S.C. § 112**

The Examiner has rejected claims 16 as not clear whether it is active or to be cancelled. Applicants clearly indicated in this Amendment that claim 16 is cancelled. The Examiner has also rejected claim 19 for improper dependency. Applicants have amended claim 19 to depend from claim 18. Accordingly, Applicants respectfully request withdrawal of this rejection.

### **III. The Rejections Under 35 U.S.C. §102**

#### *A. The Rejection Over Dawson*

The Examiner has rejected claims 1, 4-8, 11-16 and 20 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,772,427 ("Dawson"). Applicants have canceled claim 1 and changed the dependency of claims 4-8, 11-15 to depend upon claim 18. Also, Applicants have amended claim 20 so that the benefit agent is an anti-acne agent. Accordingly, Applicants respectfully request withdrawal of this rejection.

#### *B. The Rejection Over Flick*

The Examiner has rejected claims 1, 4-8, 11-16 and 20 under 35 U.S.C. §102(b) as allegedly anticipated by Cosmetic and toiletry Formulations, 2<sup>nd</sup> ed, Vol. 7 ("Flick").

Applicants have canceled claim 1 and changed the dependency of claims 4-8, 11-15 to depend upon claim 18. Also, Applicants have amended claim 20 so that the benefit agent is an anti-acne agent. Accordingly, Applicants respectfully request withdrawal of this rejection.

#### **IV. The Rejections Under 35 U.S.C. §103**

##### *A. The Rejection over Dawson In View Santora*

The Examiner has rejected claims 2, 3 and 9 as allegedly unpatentable over Dawson in view of U.S. Patent No. 6,046,145 ("Santora et al.") and U.S. Patent No. 4,375,421 ("Rubin et al."). Applicants have changed the dependency of claims 2, 3 and 9 to depend upon claim 18. Accordingly, Applicants respectfully request withdrawal of this rejection.

##### *B. The Rejection of Claims 1, 18-19 and 20*

The Examiner has rejected claims 1, 18-19 and 20 as allegedly unpatentable over U.S. Patent No. 4,514,385 ("Damani et al.") in view of Global Cosmetic, August 1999 ("Herman").

As amended, claim 18 relates to a method for treating acne of a mammal comprising topically applying, to the affected area of the skin, an effective amount of a ringing gel composition comprising (a) a surfactant phase; (b) an oil phase; and (c) a benefit agent. Claim 20 relates to a method of cleansing and delivering an anti-acne agent to the skin of a mammal, said method comprising topically applying to a desired location an effective amount of a ringing gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) an anti-acne agent. As discussed in the Specification, Applicants have discovered that ringing gel compositions according to the invention may be used to deposit benefit agents, e.g., anti-acne agents onto keratinous substrates, such as the skin, hair and nails of a human or animal, even after rinsing the composition off of the skin. This finding of a "2 in 1" composition, where the product cleanses as well as leaves a particular benefit agent behind is novel, as one would expect that the cleansing surfactants present in the composition would remove all of the benefit agent from the surface.

Damani et al. relates to anti-acne preparations comprising finely divided particles of benzoyl peroxide and salicylic acid dispersed in an aqueous carboxy vinyl polymer gel. The

problem Damani et al. attempts to solve is the incompatibility of benzoyl peroxide and salicylic acid in solution. See col. 1, lines 33-56. According to Damani et al. this problem is solved by suspending finely divided particles of both benzoyl peroxide and salicylic acid in an aqueous carboxy vinyl polymer gel. There is no mention of a ringing gel.

Recognizing this deficiency of Damani et al. the Examiner relies upon Herman. The Examiner relies upon Herman as teaching that the basic components of a ringing gel composition are oil, water, surfactant and cosurfactant. The Examiner concludes that it would have been obvious “to have modified the composition of Damani by substituting the gel vehicle with the ringing gel composition of [Herman] as motivated by the reference because Damani teaches the composition in gel, and Herman teaches that ringing gel is used for upscale skin care compositions.” Applicants respectfully disagree.

As the Examiner is well aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Here, one of ordinary skill in the art would not have been motivated to substitute the aqueous carboxy vinyl polymer gel of Damani et al. with the ringing gel composition taught by Herman since Damani et al. specifically teaches that benzoyl peroxide and salicylic acid are incompatible in solution and require the specific carboxy vinyl polymer gel to be suitable for use. One of ordinary skill in the art would expect that if you substituted the specific carboxy vinyl polymer gel with the ringing gel of Herman the salicylic acid and benzyol peroxide would be incompatible with each other. Simply because Herman teaches that the Herman ringing gel compositions are useful in upscale skin care applications does not provide one of ordinary skill in the art with the motivation that the specific carboxy vinyl polymer gel composition taught by Damani et al. could be replaced with the ringing gel composition of Herman. There is simply nothing in the teachings of Damani et al or Herman that would provide one of ordinary skill in the art with the expectation that such a substitution would be successful. Accordingly, Applicants maintain that the Examiner has failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn.

**V. Conclusion**

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding rejections. If the Examiner feels that a discussion with Applicants' representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP0529USNP/EMH. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account 10-0750/JBP0529USNP/EMH.

For all these reasons, Applicants respectfully request withdrawal of this rejection.

Respectfully submitted,

By: /Erin M. Harriman/  
Erin M. Harriman  
Reg. No. 40,410

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-3619  
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